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EXAMINER

MASDON, DAVID T

ART UNIT	PAPER NUMBER
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2188

DATE MAILED: 11/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/643,350	Applicant(s) BROWNING, JAMES V.	
	Examiner David Masdon	Art Unit 2188	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) ____ is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 16-31 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Double Patenting

Current application 10/643350 (instant) and US Patent 6,629,193 were found to have obviousness-type double patenting issues. 6,629,193 was found to have broader claims than the current application.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 16, 19-24, 27-31 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 2, 5-11, 13-18 of U.S. Patent No. 6,629,193. Although the conflicting claims are not identical, they are not patentably distinct from each other because independent claims 16 and 24 of the current application are anticipated by the respective independent claims 1 and 10 of the patent. Also, the dependent claims 19-23 and 27-31 of the current application are anticipated by the claims 5-8 and 13-18 of the respective patent.

With respect to claim 1 of the current application, please refer to the table below, which illustrates the anticipatory relationship of the claims at issue.

<u>Current Application</u>	<u>Patent</u>
16. A method for accessing personal information, comprising:	1. An information storage device, comprising:
storing personal information of a user on a storage device	the memory device holding personal information of a user of the storage device
comprising a solid-state memory device,	at least one solid-state memory device contained within the storage device
	and further comprising logic configured to partition information that is stored, wherein a portion of the stored information can be accessed without a password or a personal identification number, and the other portion of the stored information requires a password or personal identification number to access the information,
the solid-state memory device comprising at least one of an atomic resolution storage (ARS) device	wherein the at least one solid-state memory device is an atomic resolution storage (ARS) device
and a magnetic random access memory (MRAM) device;	or a magnetic random access memory (MRAM) device;
interfacing the storage device with a host computing device;	a connector for interfacing the storage device with a host computing device;
and retrieving personal information stored on the storage device with the host computing device.	(claim 9) accessing the information stored on the storage device.

Specification

1. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

The following title is suggested: --SMALL SIZE AND LARGE CAPACITY SOLID STATE PORTABLE INFORMATION STORAGE DEVICE USING ARS TECHNOLOGY AND MRAM--.

2. The disclosure is objected to because of the following informalities: on page 2, line 18-19, it is recited "The storage device comprises a connector for interfacing the storage device", it is unclear how "the connector", which is within "the storage device", interfaces "the storage device". It should be recited - -The information storage device comprises a connector for interfacing a storage device- -.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 24 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 24 recites the limitation "the personal information" in line 3. There is insufficient antecedent basis for this limitation in the claim. It is unclear if "the personal information" refers to the information mentioned in "storing information on" (line 2) or if there is different information being introduced.

Claims 25-31 are rejected because of their dependency.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 16,19-21 are rejected under 35 U.S.C. 102(b) as being anticipated by Minne' (US 6,404,647).

With respect to claim 16, Minne' discloses a method for accessing personal information, comprising:

storing personal information of a user on a storage device [(storage device is suitable for use in personal computer, hand held devices and mobile telephones, therefore, inherently contains information of the user of the device) Column 3, Lines 62-67; Column 4, Lines 21-35],

comprising a solid-state memory device, (solid-state, high density memory storage 14, Fig. 1-3)

the solid-state memory device comprising at least one of an atomic resolution storage (ARS) device [mass storage device 10 implemented with high density atomic resolution storage (ARS), Fig. 4-6; Column 4, Lines 63-66]

and a magnetic random access memory (MRAM) device; [mass storage device 10 implemented with high density magnetic random access memory (MRAM), Column 7-8; Column 7, Lines 53-59]

interfacing the storage device with a host computing device (a separate electronic device) [a connector being adapted to electronically connect mass storage device to a separate

electronic device or a device host (personal computer), Column 2, Lines 28-31; Column 3, Lines 34-46; Column 4, Lines 1-4];

and retrieving personal information stored on the storage device with the host computing device (controller comprising circuitry and software with which the controller interfaces with the device host such as a personal computer and through which all commands and/or data processes pass) [Column 3, Lines 36-48; Column 4, Lines 15-25].

With respect to claims 19 and 20, the claims require the storage device having a storage capacity of at least 2GB and 10 GB, respectively; Minne's mass storage device inherently has the required storage capacity because:

- (1) the design of the claimed storage device (Fig. 1 and 3a-3c) shows the same magnitude of that in Minne's (Fig. 2 and 4a-4c);
- (2) like the claimed storage device, Minne's mass storage device is transportable from place to place and has similar utilities and similar use in portable devices such as hand held computing devices, mobile phones and digital cameras (Column 3, Lines 62-64 and Column 4, Lines 55-62 in Minne');
- (3) Minne' discloses a desirable amount of storage can be obtained even if space is very limited [Column 8, Lines 61-65], the mass memory storage device (10) being used to provide the level of storage redundancy previously available only from a plurality of disks in a limited amount of space [Column 4, Lines 40-44], and the mass memory storage device (10) to provide a substantially larger

capacity of data storage than can conventional disk drives [Column 4, Lines 58-60]; and

(4) "A Quantum Leap Forward in Storage Capacity" (1999) published the technology of Atomic Resolution Storage (ARS) with emphasis on capacity that allows 10 gigabytes of data to be stored on a tiny compact flash, a tiny package little bigger than the size of a quarter, for use in video cameras and palm-like devices.

With respect to claim 21, the claim requires the storage device being no larger than approximately 1.75 x 1.5 x 0.125 inches in size; Minne's mass storage device inherently has the required size because:

- (1) the design of the claimed storage device (Fig. 1 and 3a-3c) shows the same magnitude of the mass storage device in Minne' (Fig. 2 and 4a-4c);
- (2) like the claimed storage device, Minne's mass storage device is transportable from place to place and has similar utilities and similar use in portable devices such as hand held computing devices, mobile phones and digital cameras (Column 3, Lines 62-64 and Column 4, Lines 55-62 in Minne'); and
- (3) Minne' discloses the mass memory storage device (10) having a 3.5 inch, 2.5 inch, 1.8 inch, or 1.0 inch form factor and the mass memory storage device (10) being sized and customized to fit in specific applications such as handheld computing devices and mobile telephones [Column 3, Lines 51-64]; and

(4) "A Quantum Leap Forward in Storage Capacity" (1999) published the technology of Atomic Resolution Storage (ARS), for use as compact flash card in a tiny package little bigger than the size of a quarter, and for use in video cameras and palm-like devices.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claim 17 is rejected under 35 U.S.C 103 (a) as being unpatentable over Minne' (US 6,404,647) as applied to claim 16 and further in view of Deo et al (US 5,721,781).

Minne' does not disclose expressly personal information comprising either account information or medical information. However, Deo et al discloses card storing medical information (column 4, lines 65-67) and account information (column 5, lines 1-4).

Minne' and Deo are analogous art because Minne' and Deo et al form the same field of endeavor, namely storing personal information and this would allow for personal information consisting of either medical information or account information. It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the specific types of personal information such as medical

information or account information of Deo et al into the system of Minne', since this would provide greater versatility to the system of Minne' ([customized to fit in other specific applications] Minne' - column 3, lines 60-66).

8. Claim 18 is rejected under 35 U.S.C 103 (a) as being unpatentable over Minne' (US 6,404,647) as applied to claim 16 and in further view of Wright et al (US 2002/0046061).

Minne' does not disclose expressly personal information comprising storing a user medical history including at least one of X-ray images and test results. However, Wright et al discloses personal data on a personal information system storing medical history, x-ray images, and lab reports (paragraph [0013]).

Minne' and Wright et al are analogous art because they are from the same field of endeavor, namely storing personal information. At the time of the invention it would have been obvious to a person of ordinary skill in the art to incorporate the personal data containing medical history, x-ray images, and lab reports of Wright et al into the system of Minne'. The motivation for doing so would have been that this would provide greater versatility to the system of Minne' ([contemplated that other types of data can be included, and the present invention is not limited to particular types of data] Wright et al – column 2, section [0013]).

9. Claim 22 is rejected under 35 U.S.C 103 (a) as being unpatentable over Minne' (US 6,404,647) as applied to claim 16 and in further view of Vogt et al (US 2004/0078511).

Minne' does not disclose partitioning the personal information so that a portion of the information can be accessed without a password or personal identification number and an other portion of the information requires a password or personal identification number to access the stored information. However, Vogt et al discloses a Main Flash array 105 that may be accessed without a password and a hidden storage that may only be accessed via access control (figure 1; column 2, paragraph [0015]).

Minne' and Vogt et al are analogous art because they are from the same field of endeavor, namely storage devices. At the time of the invention it would have been obvious to a person of ordinary skill in the art to incorporate the access controlled hidden storage along and the Main Array without access control of Vogt et al into the system of Minne'. The motivation for doing so would have been to provide stronger security to the system of Minne' ([to provide stronger security, hardware needs to be added to perform some of the security functions] Vogt et al – column 1, section [0004]).

10. Claim 23 is rejected under 35 U.S.C 103 (a) as being unpatentable over Minne' (US 6,404,647) as applied to claim 16 and in further view of Saliba (US 5,894,425).

Minne' does not disclose expressly interfacing the storage device with the host computing device via a wireless communication. However, Saliba discloses interfacing a storage device with a host computer via wireless communication (column 1, lines 5-10).

Minne' and Saliba are analogous art because they are from the same field of endeavor, namely storage devices. At the time of the invention it would have been

obvious to a person of ordinary skill in the art to incorporate the wireless interface of Saliba into the system of Minne'. The motivation for doing so would have been to provide wireless data access to a mass storage device without using cabling to the system of Minne' ([provide a system for wireless data access to a mass storage device without using conventional cabling] Saliba – column 2, lines 54-57).

11. Claims 24, 27-30 are rejected under 35 U.S.C 103 (a) as being unpatentable over Minne' (US 6,404,647) in view of Vogt et al.

The rational in the rejection of claim 16 is incorporated herein. Minne' does not disclose expressly partitioning the personal information stored on the at least one memory device so that a portion of the information can be accessed without a password or personal identification number and another portion of information requires a password or personal identification number to access the stored information. However, Vogt et al discloses a storage device with a Main Flash array being accessed without a password and a hidden storage area that can only be accessed via access control. (column 2, paragraph [0015]; figure 1).

Minne' and Vogt et al are analogous art because they are from the same field of endeavor, namely storage devices. At the time of the invention it would have been obvious to a person of ordinary skill in the art to incorporate the access controlled hidden storage and the Main Array without access control of Vogt et al into the system of Minne'. The motivation for doing so would have been to provide stronger security to

the system of Minne' ([to provide stronger security, hardware needs to be added to perform some of the security functions] Vogt et al – column 1, section [0004]).

In regard to claim 27, Minne' discloses a desirable amount of storage can be obtained even if space is very limited [Column 8, Lines 61-65], the mass memory storage device (10) being used to provide the level of storage redundancy previously available only from a plurality of disks in a limited amount of space [Column 4, Lines 40-44], and the mass memory storage device (10) to provide a substantially larger capacity of data storage than can conventional disk drives [Column 4, Lines 58-60].

In regard to claim 28, Minne' discloses a desirable amount of storage can be obtained even if space is very limited [Column 8, Lines 61-65], the mass memory storage device (10) being used to provide the level of storage redundancy previously available only from a plurality of disks in a limited amount of space [Column 4, Lines 40-44], and the mass memory storage device (10) to provide a substantially larger capacity of data storage than can conventional disk drives [Column 4, Lines 58-60].

In regard to claim 29, Minne' discloses the mass memory storage device (10) having a 3.5 inch, 2.5 inch, 1.8 inch, or 1.0 inch form factor and the mass memory storage device (10) being sized and customized to fit in specific applications such as handheld computing devices and mobile telephones [Column 3, Lines 51-64].

In regard to claim 30, Minne' discloses a mass storage device 10 implemented with high-density atomic resolution storage (ARS) (Fig. 4-6; Column 4, Lines 63-66) and a mass storage device 10 implemented with high-density magnetic random access memory (MRAM) (Column 7-8; Column 7, Lines 53-59).

12. Claim 25 rejected under 35 U.S.C. 103(a) as being unpatentable over Minne' (US 6,404,647) in view of Vogt et al as applied to claim 24 above, and further in view of Deo et al.

Minne' and Vogt et al do not disclose expressly storing information comprises storing at least one of contact information, scheduling information, account information, medical information, application files, entertainment features, photographs, Internet settings and favorites, computer applications, and interface preferences. However, Deo et al discloses card storing medical information (column 4, lines 65-67) and account information (column 5, lines 1-4).

Minne' and Vogt et al and Deo et al are analogous art because they are from the same field of endeavor, namely storage devices. At the time of the invention it would have been obvious to a person of ordinary skill in the art to incorporate the specific types of personal information such as medical information or account information of Deo et al into the system of Minne' and Vogt et al. The motivation for doing so would have been that this would provide greater versatility to the system of Minne' ([customized to fit in other specific applications] Minne' - column 3, lines 60-66).

13. Claim 26 rejected under 35 U.S.C. 103(a) as being unpatentable over Minne' (US 6,404,647) in view of Vogt et al as applied to claim 24 above, and further in view of Wright et al.

Minne' and Vogt et al do not disclose expressly storing information comprises storing a user medical history including at least one of X-ray images and test results. However, Wright et al discloses personal data on a personal information system storing medical history, x-ray images, and lab reports (paragraph [0013]).

Minne' and Vogt et al and Wright et al are analogous art because they are from the same field of endeavor, namely storing personal information. At the time of the invention it would have been obvious to a person of ordinary skill in the art to incorporate the personal data containing medical history, x-ray images, and lab reports of Wright et al into the system of Minne' and Vogt et al. The motivation for doing so would have been that this would provide greater versatility to the system of Minne' ([contemplated that other types of data can be included, and the present invention is not limited to particular types of data] Wright et al – column 2, section [0013]).

14. Claim 31 rejected under 35 U.S.C. 103(a) as being unpatentable over Minne' (US 6,404,647) in view of Vogt et al as applied to claim 24 above, and further in view of Saliba.

Minne' and Vogt et al do not disclose expressly interfacing the storage device with the host computing device comprises interfacing the storage device with the host computing device via a wireless communication. However, Saliba discloses interfacing

a storage device with a host computer via wireless communication (column 1, lines 5-10).

Minne' and Vogt et al and Saliba are analogous art because they are from the same field of endeavor, namely storage devices. At the time of the invention it would have been obvious to a person of ordinary skill in the art to incorporate the wireless interface of Saliba into the system of Minne' and Vogt et al. The motivation for doing so would have been to provide wireless data access to a mass storage device without using cabling to the system of Minne' ([provide a system for wireless data access to a mass storage device without using conventional cabling] Saliba – column 2, lines 54-57).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Masdon whose telephone number is (571) 272-6815. The examiner can normally be reached on Monday - Friday, 7:30am - 4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mano Padmanabhan can be reached on (571)272-4210. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2188

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DM

Mano Padmanabhan
10/14/05

**MANO PADMANABHAN
SUPERVISORY PATENT EXAMINER**